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1/30/09

In re Application of: :
GINSBERG, PHILIP M. et al :
Serial No.: 09/846,025 :
Filed: April 30, 2001 : DECISION ON PETITION
Docket: 00-1020 :
Title: REAL-TIME INTERACTIVE :
WAGERING ON EVENT OUTCOMES :

This is a decision on the petition filed on January 9, 2009 by which petitioner requests withdrawal of the restriction requirement mailed December 20, 2007, and that non-elected claims 56-60 and 63-65 be rejoined and examined on the merits. Claims 11, 13, 15 and 61-62 were elected and examined. This petition is being considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is dismissed.

Discussion and Analysis

A review of the record reveals that a restriction requirement under MPEP § 806.05(d)¹ was issued on Dec. 20, 2007 between four disclosed and claimed related inventions and further

¹ 806.05(d) [R-5] Subcombinations Usable Together Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants. > To support a restriction requirement where applicant separately claims plural subcombinations usable together in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctness and reasons for insisting on restriction are necessary. Each subcombination is distinct from the combination as claimed if: (A) the combination does not require the particulars of the subcombination as claimed for patentability (e.g., to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination. See MPEP § 806.05(c). Furthermore, restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search. Where claims to two or more subcombinations are presented along with a claim to a combination that includes the particulars of at least two subcombinations, the presence of the claim to the second subcombination is evidence that the details of the first subcombination are not required for patentability (and vice versa). For example, if an application claims ABC/B/C wherein ABC is a combination claim and B and C are each subcombinations that are properly restrictable from each other, the presence of a claim to C provides evidence that the details of B are not required for the patentability of combination ABC. Upon determining that all claims directed to an elected combination invention are allowable, the examiner must reconsider the propriety of the restriction requirement. Where the combination is allowable in view of the patentability of at least one of the subcombinations, the restriction requirement between the elected combination and patentable subcombination(s) will be withdrawn; furthermore, any subcombinations that were searched and determined to be allowable must also be

election of species. The applicant elected with traverse claims 11, 13, 15 and 61-62 which are directed to Group I invention and Species (c).

In judging the propriety of the restriction requirement, the related inventions, as claimed, must be shown to be distinct. See MPEP 802.01. In the instant application, the distinctness between the claimed inventions was justified as stated in the examiner's restriction requirement of December 20, 2007 in that the subcombinations do not overlap in scope and are not obvious variants. The subcombination also is separately usable by itself. The examiner further gave an example to support his conclusion that the subcombination has separate utility such as a system in which the player uses his own money instead of credit. The examiner has satisfied the showing of distinction requirement set forth in MPEP § 806.05(d).

In the December 20, 2007 Office action, the examiner further required election of species on the basis of being patentably distinct. According to MPEP 806.04², a restriction is proper if the species are independent or distinct. In addition, there must be a patentable difference between the species as claimed as required by MPEP 806.04(h)³. A review of the record shows that the applicant has not clearly admitted on the record that the species are not patentably distinct or identify any evidence showing the species to be obvious variants (see the last paragraph of page 5 of the Office action of December 20, 2007). Since the claims directed to the Species A-E are patentable over each other, then, the election of species requirement of December 20, 2007 is proper.

Furthermore, the examiner must establish there is a serious burden on the examiner if restriction is not required, pursuant to MPEP 808.02. In particular, MPEP 808.02(C)⁴ states that a serious burden exists where it is necessary for the examiner to search different fields for the restricted species. On page 3 of the December 20, 2007 Office action, the examiner noted that the various inventions and species do require different fields of search. In particular, the serious search burden arises from the characteristics of Species A-E. Each species does require a different field of search in different classes/subclasses or electronic resources and/or using different search queries. It should be noted that the application of prior art references to one invention and one species would not likely be applicable to another invention and another species. Petitioner also argues that the examiner failed to explain why there would be a serious search burden on the examiner if restriction is not required. A careful study of claims 56-57 which call for a credit limit and a maturity date and time clearly requires a prior art search in a system with a credit

rejoined. If a subcombination is elected and determined to be allowable, nonelected claims requiring all the limitations of the allowable claim will be rejoined in accordance with MPEP § 821.04.

² MPEP 806.04**>Genus and/or Species< Inventions [R-3]

**>Where an application includes claims directed to different embodiments or species that could fall within the scope of a generic claim, restriction between the species may be proper if the species are independent or distinct.

³ MPEP 806.04(h)Species Must Be Patentably Distinct From Each Other[R-3]

**In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other **. Where generic claims are

⁴ MPEP 808.02 Establishing Burden [R-5]

(C)A different field of search: Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

limit or a system that has a maturity date and time or systems with any combination or permutation of the two. Claims 61-63 call for displaying a list based on a wagering limit and updating the list every time the price of the wager changes. Clearly these claims have mutually exclusive characteristics. This imposes a significant search burden. Furthermore, there is nothing about displaying lists in the other claims. If, for instance, a search the concept behind claim 56 is made, then, the examiner still has to search the concept behind claim 61. Again, this poses a significant search burden. Claims 64-65 are directed to how the event wagered upon is associated with a market for an item, but they require a determination that the price is not available for one of the outcomes and calculating the unavailable price. This has no relationship with any of the other claims. In this regard, a Class 705 and non-patent literature search would have been required. Based on the diverse subject matter of these claims, a search in Classes and subclasses of 463/25-29; 463/16, 20, 42; Class 715/810 and Class 434 are required. Additionally, text search inquiries would involve different search applications for at least some of the grouped inventions. The potential additional classification and text searching possible also is a sufficient showing of serious burden existing in examining the claims together and is considered implied by the requirement as set up by the examiner. The different classifications and searches as provided by the examiner are sufficient to show serious burden. Because the inventions are independent or distinct for the reasons given in the restriction requirement, and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is deemed appropriate.

Conclusion

For the reasons outlined above, the restriction requirement imposed in the December 20, 2007 Office action and made final in the July 9, 2008 Office action is in accordance with proper Office procedure. Accordingly, the restriction requirement and election of species requirement is proper. The request to have the restriction requirement withdrawn will not be granted.

The application is being forwarded to Supervisory Patent Examiner of Art Unit 3714 for further examination and consideration of the latest amendment filed on January 9, 2009. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-4514.

Accordingly, the petition is dismissed.



Robert Olszewski, Director
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